REMARKS

The present amendment is filed concurrently with a Request for Continued Examination (RCE). The Director is authorized to charge the RCE and extension of time fees to the assignee's deposit account number 15-06-35.

Claims 1, 2, 4, 5, 7-11 and 13-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiden. Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 1 and its dependent claims

Claim 1 has been amended to specify that a bank carries out the claimed steps. Moreover, the sending step now recites that the bank sends a shipping identifier and the address associated with the customer's account at the bank to the shipper. The Heiden reference does not teach or suggest these steps.

The Office based its rejection upon an interpretation of Heiden in which the claimed "third party" was the "party who controls the host system", and points to Heiden at Col. 7, lines 1-40 in support thereof. (Paper number 7, page 2). However, Heiden is clear that the party who controls the host system is the party that produced the mailpiece MP:

> Note that, in accordance with the subject invention, the delivery information is not disclosed to the party who controls the host system 54; i.e., the party producing the mailpiece MP, in order to maintain security of the mailing. Col. 7, lines 25-28.

According to the Examiner's interpretation of Heiden, therefore, the "third party" is the party who controls the host system and that party is the vendor. To reconcile Heiden and the Examiner's interpretation thereof, the

third party = party who controls host system = party who produces mailpiece MP = vendor

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.Continuing, Heiden also states that the "system 50 accesses the data store 52 which stores a data base of delivery information." Col 7, lines 4-5. Heiden continues at Col. 7, line 9: "When system 50 inputs selection criteria for the mailing list...it accesses data store 52 to recover an appropriate list and down loads the list over communication link 53 to host data processing system 54. If, as suggested by the Examiner, the party who controls the host system 54 is the vendor, then the vendor, according to Heiden, is then provided with the contents of the data store 52 of delivery information. If the vendor has control over the host system 54, and receives the delivery information from the system 50, the vendor then knows the delivery information. If the host system 54 is controlled by the vendor and the vendor is given the delivery information, how then is the shipment anonymous? The answer is that it cannot and that the Examiner's interpretation of Heiden is in error and at odds with the explicit teachings of Heiden itself - as shown by the portion of Heiden excerpted immediately above.

Heiden does not teach or suggest any method for a bank to enable anonymous shipment of a package containing goods purchased by a customer from a vendor for delivery to an address unknown to the vendor. In the presently claimed embodiment of the present invention, the address that is sent to the shipper (and the shipper only) is an address that is associated with the customer's account at the bank, as recited by the sending step of independent claim 1:

> sending a shipping identifier *and the address associated with the customer's account to the shipper*, whereby the shipper...

Heiden does not teach that the shipper is sent a shipping identifier and an address associated with a customer's account at the customer's bank. Also, Heiden does not teach or suggest a bank authenticating the customer and guaranteeing payment on the draft if bank-imposed restrictions are met, as claimed. In fact, Heiden is not believed to teach or suggest any role for banks, and much less the central role defines by the claimed steps of claim 1. It is, therefore, respectfully requested

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that the 35 U.S.C. § 103(a) rejections applied to claim 1 not be re-applied to amended claim 1 and its dependent claims, for the reasons detailed above.

Claim 7 and its dependent claims

Amended claim 7 recites that the shipper receives the package code from a bank at which the customer maintains an account.

> receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account;

According to the present invention, and as claimed in each of the independent claims herein, the delivery information is kept secure and in the control of the entity that already bears a fiduciary relationship with the customer: the customer's bank. The customer's bank is the party that already holds the customer's money as well as his or her address(es). The claimed inventions, therefore, place the bank squarely in the middle of the transaction to intermediate between the customer and the vendor, as evidenced by the claimed steps. It is the bank, according to the claimed embodiments of the present invention, that guarantees payment and/or pays on the draft presented to it by the customer or the vendor and it is the bank that sends the shipper the account holder's address, bypassing the vendor in the manner claimed herein. Heiden does not teach or suggest any role for the customer's bank, and much less the central role discharged by the customer's bank according to the claimed invention. It is, therefore, also respectfully requested that the 35 U.S.C. § 103(a) rejections applied to claim 7 not be re-applied to amended claim 7 and its dependent claims.

Claim 13 and its dependent claims

Amended claim 13 recites:

> sending a request for a package code to a bank at which the customer maintains an account and an electronic draft for payment of the goods on behalf of the customer;

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> rec iving payment n the draft and the package code from the bank nly if
> the customer is authenticated by the bank and bank-imposed constraints
> are satisfied, the package code being devoid of delivery address
> information;

The embodiment of the present invention defined by claim 13 requires that the vendor send

a request for a package code to a bank at which the customer maintains an account, as well as send

(or cause to be sent) an electronic draft on behalf of the customer to the bank. Thereafter, only if the

customer (the drawer of the sent electronic draft) is authenticated by the bank and only if bank-

imposed constraints are satisfied or met (e.g., sufficient funds on deposit in the account to cover the

draft or sufficient credit) does the bank send the requested package code and payment or assurance

of future payment on the draft. This subject matter is not taught or suggested in the Heiden

reference. As stated above, Heiden does not teach or suggest any role for any bank in the shipping

method disclosed therein. As such claim 13 and its dependent claims are believed to be patentable

relative to this reference.

Claim 18 and its dependent claims

Claims 18-28 were rejected as being unpatentable over Shkedy in view of Heiden.

Reconsideration and withdrawal of these rejections are respectfully requested.

The primary reference to Shkedy relates to "... a system and method for facilitating a

transaction between a plurality of buyers, an intermediary, and a plurality of sellers over an

electronic network" Col. 1, lines 10-12.   Shkedy's system and method is one in which all

information regarding the buyers and sellers is held by a central "Controller" or electronic market

operator. The Office attempts to combine the teachings of Shkedy with his central controller

containing both the vendors' and customers' confidential information with the teachings of Heiden,

in which the third party that controls the host system is the vendor (according to the Examiner's

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interpretation). The combination does not work, however. It is difficult to see how a shipment could be anonymous in such a combination. Either the vendor controls the host system that has access to the confidential information or it does not. Either Shkedy's "Controller" controls the buyer and seller information or it does not. If both Heiden's vendor and the "Central Controller 200" control and/or have access to the party's confidential information (e.g., delivery address and the like), the transaction is no longer anonymous. In Shkedy, at least three parties have access to the confidential information: the buyer's bank, the "Controller 200" and the shipper. In col. 10, lines 1-10, Shkedy describes the wealth of confidential buyer information that is stored in Shkedy's Buyer Database 255, such as name, address, telephone number, credit card number, etc. Shkedy actually teaches away from the embodiment of claim 18. Shkedy's Central Controller 200 hardly makes for an anonymous transaction - and is at odds with the Heiden model of third party (vendor) holder of confidential information. It is respectfully submitted that those of skill in this art at the time the claimed invention was made would never have been motivated to combined Shkedy and Heiden, for the simple reason that they both espouse completely diverging views on where and how the parties to the transaction's confidential information should be stored and handled. Moreover, if these references were to be combined, the invention of claim 18 would not suggest itself. Even if the central controller 200 of Shkedy would be used to intermediate between the buyer and seller in Shkedy's electronic marketplace, and even if the mailpieces were to be generated in the manner of Heiden, the resultant transactional landscape would bear little resemblance to the method of claim 18 in which the <u>bank</u> carried out steps of:

> **retrieving at least the authenticated customer's financial information and delivery address;**
>
> **honoring a draft presented by the vendor for payment of the item only when the customer is successfully authenticated by the bank <u>and bank-imposed constraints are satisfied</u>;**

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> generating a package code for the item, the generated package code being
> devoid f customer confidential information and devoid of delivery address
> information;
>
> associating the retrieved delivery address to the generated package code
>
> sending only the package code to the vendor, the vendor affixing the
> package code to the package, and
>
> sending the package code and the associated delivery address to a shipper
> for storage in a shipper database

In this method, the buyer's confidential information is not given to some "central controller", but kept by the bank, which is the party to the transaction that is already tasked with preserving the buyer's information confidential (and subject to federal laws and regulations). Shkedy, in Col 25, lines 31-61, makes mention of banks and their roles within the central controller scheme disclosed therein. **In Shkedy, the role of banks is expressly limited to acting as certificate authorities (CAs) for issuing digital certificates and certifying an individual's ability to pay or deliver the goods.** Col. 25, lines 51-61. Shkedy, therefore, either taken alone or in combination with Heiden, does not teach or suggest the claimed invention. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections applied to the claims are, therefore, respectfully requested.

Claim 27 and its dependent claims

Claim 27 recites that

> the customer maintaining an account at the bank, the bank carrying out the
> steps of:
>
> receiving the electronic draft for the purchase of the goods along with a
> request for a package code;
>
> authenticating the customer and guaranteeing payment to the vendor on
> the draft only if the customer is authenticated and bank-imposed
> restrictions are met;
>
> if the customer is authenticated and bank-imposed restrictions are met,
> generating and storing a the package code for the item goods, the generated
> package code being devoid of electronic delivery address information;
>
> storing the specified electronic delivery address;

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associating the stored electronic deliv ry address to the generated and stored package c de;

sending the vendor a package code and an associated forwarding electronic address, the forwarding electronic address being different from the electronic delivery address, the vendor forwarding the goods and the package code to the forwarding electronic address associated with the received package code;

retrieving the forwarded goods and the package code from the forwarding electronic address;

reading the forwarded package code and retrieving the stored electronic delivery address associated therewith, and

delivering the goods to the retrieved electronic delivery address.

Shkedy, contrary to the Examiner's assertion, does not teach that the associating and storing steps may be carried out by a bank. As noted above, in Shkedy, the bank's role is limited to that of a certificate authority for digital certificates and certifying individual's ability to pay or deliver the goods. Shkedy only states that his product uses open standards based on Internet protocols. Col. 11, lines 36-41. Shkedy simply does not teach or suggest, alone or in combination with Heiden, the steps of retrieving forwarded goods and a package code from a forwarding electronic address, reading the forwarded package code and retrieving the stored electronic address and delivery the goods from the forwarding electronic address to the electronic delivery address, as claimed. Shkedy merely stating this his network interface uses open standards based on Internet protocols (thereby allowing users to exchange electronic files - which was well known even in 1998, the filing date of the Shkedy reference) does not rise to the level of teaching or suggesting the claimed steps, even when such teachings are combined with Heiden's third party (vendor)-centric model. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections applied to the pending claims are, therefore, respectfully requested.

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Applicant's attorney, therefore, respectfully submits that all remaining claims are allowable and that the present application in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,

Date: Feb. 9, 2004   By: _____
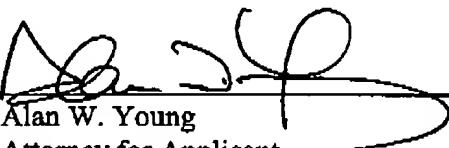
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